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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,283	06/30/2003	David J. Burton	J103UB02US00	5802
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EXAMINER				
VETTER, DANIEL				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/612,283

Applicant(s)

BURTON ET AL.

Examiner

DANIEL P. VETTER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 1-18 were previously pending in this application. Claims 1 and 13 were amended in the reply filed May 21, 2008. Claims 1-18 are currently pending in this application.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 21, 2008 has been entered.

Response to Arguments

3. Applicant's amendments overcome the rejections made to claims 1-9 and 13-17 under § 112, second paragraph, and these are withdrawn.

4. Applicant's arguments with respect to the rejections made under § 103(a) have been fully considered but they are not persuasive. Applicant argues that the combination of Keong and Bruns does not render the claimed invention obvious because neither reference uses postal costs to determine a number of packages in a shipment. Specifically, applicant notes that "Keong does disclose storing data relating to postal cost in a database, but the data is used strictly to determine the shipping cost for the package so that it can be provided to customers in real-time and is not used to determine the number of packages in the shipment." Remarks, page 9 (emphasis in original). Contrary to this assertion, Keong additionally uses postal costs to determine a size of a package containing multiple items (§ 0089). This determination of a proper package size is done when a customer orders multiple items, such as five books, and also takes into account the size and weight of the items (§ 0089). Bruns, on the other

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hand, uses similar criteria (size and weight) to determine how to split up an order into multiple shipments (§ 0005), rather than determining a proper size of a singular package. Accordingly, examiner respectfully maintains that the claimed invention is an obvious combination of Keong and Bruns, by substituting the determination of a number of packages containing multiple items in Bruns for the determination of a size of a package containing multiple items in Keong. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of number determination (Bruns) for size determination (Keong). Both of these determinations serve the same purpose (fulfilling customer orders of multiple items), and one skilled in the art would have recognized that this substitution could be implemented through routine engineering producing predictable results.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. Claims 1-3 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different

state). The claims do not recite any computerized or mechanical apparatus used to perform the process. And while the claimed invention determines a number of packages, the actual packaging steps themselves are never recited (such steps subsequently appear in dependent claim 4). As such, the claims concretely identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claims 17 and 18 recite the limitation "the sub-orders." There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3-5, 9-10, 12-14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keong, U.S. Pat. Pub. No. 2005/0102203 (Reference A of the attached PTO-892) in view of Bruns, U.S. Pat. Pub. No. 2004/0107151 (Reference B of the PTO-892 part of paper no. 20070105).
13. As per claims 1, Keong teaches storing item characteristics for a plurality of items (¶ 0017); storing postal costs for packages based on package characteristics (¶ 0021);

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receiving a customer order specifying a plurality of items for a shipment, the shipment comprising at least one package (§ 0023); storing a list comprising identifiers corresponding to the plurality of items specified by the customer (§ 0026); automatically determining a size of package comprising the shipment and determining which items of the customer order will be contained in each package (§ 0089); the determining step carried out based on the identifiers, the stored item characteristics corresponding to the identifiers, and the postal costs for packages (§ 0089). Keong does not explicitly teach determining a number of rather than the size of the packages; which is taught by Bruns (§ 0005). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Bruns into the method taught by Keong so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, § 0009); and also in the event that the vendor at that time can only partially fulfill an order (as taught by Keong; § 0097). Moreover, since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of number determination (Bruns) for size determination (Keong). Both of these determinations serve the same purpose (fulfilling customer orders of multiple items), and one skilled in the art would have recognized that this substitution could be implemented through routine engineering producing predictable results.

14. As per claim 3, Keong in view of Bruns teaches the method of claim 1 as described above. Keong further teaches said stored item characteristic includes at least of: item weight, item thickness and item size (§ 0084).

15. As per claim 4, Keong in view of Bruns teaches the method of claim 1 as described above. Keong further teaches printing respective mailers (§ 0131), each mailer corresponding to a package for the shipment, each mailer defining customer selected items to comprise the corresponding package (§ 0126); placing each mailer on an assembly line (§§ 0118, 0126, Fig. 1); and placing each customer selected item comprising each package on the corresponding mailer as the mailer traverses the

assembly line (§ 0127). Examiner is interpreting a network of sorting stations and order assembly bays as an assembly line. Examiner notes that although Keong teaches using two separate labels corresponding to the package, it would have been obvious at the time of invention to combine these labels onto the single mailer according to known methods to achieve a predictable result. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (holding that combining prior art elements into one piece would be an obvious engineering choice).

16. As per claim 5, Keong in view of Bruns teaches the method of claim 4 as described above. Keong further teaches each mailer comprises a printed paper mailer (§ 131); each paper mailer includes, on a first side, an RF tag indicative of the items to be packaged with the mailer and on a second side printed information. Examiner acknowledges that Keong teaches using an RF tag rather than the claimed bar code, however it would have been obvious at the time of invention to use a bar code instead of an RF tag because Keong explicitly teaches the use of bar codes for this purpose in prior art systems, even though they are not employed in the preferred embodiment (§ 0004). Additionally, although Keong does not explicitly teach that the printed information on the second side of the mailer is the customer address, instead teaching that a second label is applied subsequently that contains this information (§ 0131), it would have been obvious at the time of invention to combine these labels into a single mailer according to known methods to achieve a predictable result. *Larson*, 340 F.2d at 968.

17. As per claim 9, Keong in view of Bruns teaches the method of claim 4 as described above. Keong further teaches receiving a customer order is performed at a location geographically remote from the step of placing each mailer on an assembly line (§ 0094).

18. As per claim 10, Keong teaches a processor (§ 0082 - "computer"); a memory connected to the processor, the memory storing data and instructions for controlling the operation of the processor; the processor operative to perform the steps of (§ 0082 - "computer"): storing item characteristics for a plurality of items (§ 0017); storing postal

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costs for packages based on package characteristics (§ 0021); receiving a customer order specifying a plurality of items for a shipment (§ 0023); storing a list comprising identifiers corresponding to items to comprise the shipment (§§ 0026, 78); automatically determining a size of package comprising the shipment and determining which items of the customer order will be contained in each package (§ 0089); the determining step carried out based on the identifiers and the postal costs for packages (§ 0089). Keong does not explicitly teach determining a number of rather than the size of the packages; which is taught by Bruns (§ 0005). It would have been *prima facie* obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Bruns into the method taught by Keong so that the customer will receive products faster by eliminating delivery constraints (as taught by Bruns, § 0009); and also in the event that the vendor at that time can only partially fulfill an order (as taught by Keong; § 0097). Moreover, since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that is, in the substitution of number determination (Bruns) for size determination (Keong). Both of these determinations serve the same purpose (fulfilling customer orders of multiple items), and one skilled in the art would have recognized that this substitution could be implemented through routine engineering producing predictable results.

19. As per claim 12, Keong in view of Bruns teaches the system of claim 10 as described above. Keong further teaches the selected characteristic is chosen from the group comprising: item weight, item thickness and item size (§ 0084).

20. As per claim 13, Keong in view of Bruns teaches the system of claim 10 as described above. Keong further teaches including the step of printing a mailer for each package (§ 0131); placing each mailer on an assembly line (§§ 0118, 0126, Fig. 1); and placing each item in each package on the associated mailer as the mailer traverses the assembly line (§ 0127). Examiner notes that although Keong teaches using two separate labels corresponding to the package, it would have been obvious at the time of

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invention to combine these labels onto the single mailer according to known methods to achieve a predictable result. *Larson*, 340 F.2d at 968. Bruns further teaches that the packages are packages of a shipment (§ 0017); which would have been prima facie obvious because the order has been split (as taught by Bruns, § 0009).

21. As per claim 14, Keong in view of Bruns teaches the system of claim 13 as described above. Keong further teaches each mailer comprises a printed paper mailer (§ 131); each paper mailer includes, on a first side, an RF tag indicative of the items to be packaged with the mailer and on a second side printed information. Examiner acknowledges that Keong teaches using an RF tag rather than the claimed bar code, however it would have been obvious at the time of invention to use a bar code instead of an RF tag because Keong explicitly teaches the use of bar codes for this purpose in prior art systems, even though they are not employed in the preferred embodiment (§ 0004). Additionally, although Keong does not explicitly teach that the printed information on the second side of the mailer is the customer address, instead teaching that a second label is applied subsequently that contains this information (§ 0131), it would have been obvious at the time of invention to combine these labels into a single mailer according to known methods to achieve a predictable result. *Larson*, 340 F.2d at 968.

22. As per claim 18, Keong in view of Bruns teaches the system of claim 10 as described above. Keong further teaches receiving a customer order is performed at a location geographically remote from the step of placing each mailer on an assembly line (§ 0094).

23. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keong in view of Bruns as applied to claims 1 and 10 above, in further view of a finding of Official Notice considered admitted prior art.

24. As per claims 2 and 11, Keong in view of Bruns teaches the method of claim 1 and the system of claim 10 as described above. Keong in view of Bruns does not explicitly teach the customer order is received by mail on a pre-printed form. Official

Notice was previously taken and not disputed that it is old and well known in the art to employ pre-printed forms for mail order. There has been no attempt to traverse this finding despite the opportunity to do so and it is considered admitted prior art. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the method taught by Keong in view of Bruns to receive the orders from customers on forms that are pre-printed by the company in order to make order processing standardized and therefore simpler.

25. Claims 6-7 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keong in view of Bruns as applied to claims 5 and 14 above, in further view of Farmer, U.S. Pat. No. 2,276,293 (Reference C of the PTO-892 part of paper no. 20070105).

26. As per claims 6 and 15, Keong in view of Bruns teaches the method of claim 5 and the system of claim 14 as described above. Keong further teaches a scanner for reading the RF tag on each mailer (§ 0135). It would have been obvious to replace the RF tag with a bar code for the reasons set forth in claim 5 above. Keong in view of Bruns does not explicitly teach a plurality of hoppers, each hopper containing a plurality of like items; and a mechanism responsive to electrical control for moving an item from a hopper onto a mailer. Farmer teaches a plurality of hoppers (page 2, left column, line 8), each hopper containing a plurality of like items (page 2, left column, line 9); and a mechanism for moving an item from a hopper onto a mailer (page 4, right column, line 71 - page 5, left column, line 2). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Farmer into the method taught by Keong in view of Bruns in order to reduce cost, minimize time involved, and insure greater accuracy in assembling orders (as taught by Farmer, page 1, left column, lines 39-41). Farmer teaches that the mechanism is electronically actuated using a circuit (page 3, left column, lines 9-10) but does not explicitly teach that the mechanism is responsive to computer control. However, it

would have been obvious at the time of invention and a matter of routine engineering by known methods to use any computer for control such as the one envisioned by Keong (¶ 0067) to achieve the predictable result of a more accurately controlled mechanism.

27. As per claims 7 and 16, Keong in view of Bruns and Farmer teaches the method of claim 6 and system of claim 15 as described above. Keong further teaches the mailer including a printed information side for displaying information visually; but does not teach that this is a message indicating that a customer order has been fulfilled in multiple packages. However, this printed matter is non-functional descriptive material and cannot lend patentability to an invention that would have otherwise been unpatentable over the prior art. *In re Ngai*, 367 F.3d 1336, 1339; 70 USPQ2d 1862, 1864 (Fed. Cir. 2004); cf. *In re Gulack*, 703 F.2d 1381, 1385; 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

28. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keong in view of Bruns and Farmer as applied to claims 7 and 16 above, in further view of a finding of Official Notice considered admitted prior art.

29. As per claim 8, Keong in view of Bruns and Farmer teaches the method of claim 7 as described above. Keong in view of Bruns and Farmer does not teach shrink-wrapping each of the packages in a plastic wrap so that the customer address and customer message are readable through the plastic wrap. Official Notice was previously taken and not disputed that it is old and well known in the art to shrink-wrap each of the packages in a plastic wrap so that an address and message are readable through the plastic wrap. There has been no attempt to traverse this finding despite the opportunity to do so and it is considered admitted prior art. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the method taught by Keong in view of Bruns

and Farmer because plastic wrap is commonly used in such a manner when shipping packages to provide stability and protection.

30. As per claim 17, Keong in view of Bruns and Farmer teaches the system of claim 16 as described above. Bruns further teaches that the orders are sub-orders (§§ 0017) and it would have been prima facie obvious to include that the orders are sub-orders because the order has been split (as taught by Bruns, § 0009). Keong in view of Bruns and Farmer does not teach that packaging each of the orders includes shrink-wrapping each of the orders in a plastic wrap so that the customer address and customer message are readable through the plastic wrap. Official Notice was taken as above that it is old and well known in the art to shrink-wrap orders in a plastic wrap so that an address message are readable through the plastic wrap. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the system taught by Keong in view of Bruns and Farmer because plastic wrap is commonly used in such a manner when shipping packages to provide stability and protection.

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Igor N. Borissov/

Primary Examiner, Art Unit 3628